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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,192	12/15/2003	Kenneth A. Williams	06975-221002	2149

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FISH & RICHARDSON P.C.  
P.O. BOX 1022  
MINNEAPOLIS, MN 55440-1022

EXAMINER
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DUFFY, DAVID W

ART UNIT	PAPER NUMBER
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3714

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02/05/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/734,192	WILLIAMS ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	David W. Duffy	3714	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 February 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/15/2003</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement filed 12/15/2003 fails to comply with 37 CFR 1.98(a)(1), which requires the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office; (2) U.S. patents and U.S. patent application publications listed in a section separately from citations of other documents; (3) the application number of the application in which the information disclosure statement is being submitted on each page of the list; (4) a column that provides a blank space next to each document to be considered, for the examiner's initials; and (5) a heading that clearly indicates that the list is an information disclosure statement. The information disclosure statement has been placed in the application file, but the information referred to therein has not been considered unless cited by the examiner.
2. The information disclosure statement filed 12/15/2003 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the cited documents are from parent cases and are marked by other examiners, have improper serial numbers, and/or lack a listing and area for examiner initials. It has been placed in the application file, but the information referred to therein has not been considered as to the merits unless cited by the examiner. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement,

including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

### ***Specification***

3. The abstract of the disclosure is objected to because it is of undue length.

Correction is required. See MPEP § 608.01(b).

4. The disclosure is objected to because of the following informalities: In the cross reference paragraph application 07/656,292 should be listed as abandoned. Application 08/149,026 should be listed as patent number 6,692,359. Application 08/149,026 is listed as a continuation-in-part of application 07/656,292 while it is a continuation according to Patent No. 6692359. Specification page 5, line 4: MacIntosh is incorrect. Macintosh is the proper form.

Appropriate correction is required.

### ***Claim Objections***

5. Claim 23 is objected to because of the following informalities: the claim recites the limitation "wherein the gradations of *skill* include a level representing relatively *litter interest*, a level representing relatively intermediate *interest*, and a level representing relatively great *interest*"(emphasis added) examiner believes the use of interest is in error. Appropriate correction is required.

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims

are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-39 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-62 of U.S. Patent No. 6692359.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 2-11 are directed to identical subject matter differing only in that the instant application uses slightly broader language to include a user profile related to any activity instead of the patent's language directed solely to profiles related to video games players. Claims 12-39 are not patentably distinct because they are directed to identical subject matter differing only in that the instant application display's a user's skill level primarily and then includes a user's interest level instead of the patent's claims directed to a user's interest level and then including a user's skill level.

#### ***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 2-11 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for displaying gradation of interest in games, does not reasonably provide enablement for level of interest in items. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. The specification provides for the disclosure of personal interest in a variety of games relative to other games (fig 6, specification page 2, line 20- page 3, line 5, and specification page 8, lines 5-7). The disclosure describes enabling a user to list various interest and hobbies (specification page 8 line 20- page 9, line 2). The disclosure does not describe the user providing information related to interest or skill level for any item other than video games.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claim 24 recites the limitation "the rendered profile information" in the second line of the claim. There is insufficient antecedent basis for this limitation in the claim.

12. Claim 38 recites the limitation "the rendered profile information" in the second line of the claim. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over "How to get the most out of COMPUSERVE, 4<sup>th</sup> edition, 1989" (hereafter Bowen) in view of Official Notice.

15. In regards to claim regards to claim 2, Bowen discloses a computer implemented method of creating a user profile for interacting on a computer network, the method comprising enabling a first user to identify profile information with respect to each of one or more items (pgs 94-95, 207-209, and 381: "create and read personal bios"); and enabling the first user to make the profile information accessible to a first remote computer system, a central computer system, and at least one other remote computer system (pg 207-209, making a profile while online for other members to view), wherein the first computer system, the central computer system, and at least one other remote computer system are elements of a computer network used for multi-user communications (CompuServe is an online multi-user environment). Bowen lacks disclosing displaying several gradations of interest, the gradations of interest including a level representing relatively little interest, a level representing relatively intermediate interest, and a level representing relatively great interest and the profile information including a level of interest that is selected from among the several displayed gradations of interest.

16. Examiner takes OFFICIAL NOTICE that it is well known for people to rate their interest relative to their other interests and providing a scale would allow users to quantify their level of interest to facilitate finding other users of a similar interest level.

17. Therefore it would have been obvious to one skilled in the art at the time of the invention to have modified Bowen in view of official notice to have included a scale for rating interest in order to allow users to find other users with similar levels of interest in similar areas.

18. In regards to claim 3, Bowen discloses the method of claim 2, but lacks wherein the profile information is automatically displayed upon the second user taking an action demonstrating an interest in the first user. However, Bowen discloses the ability of a user to look up other user's profiles (pg 208, search by) and it would have been obvious to automate the manual task of searching to allow a user to view profile information of a selected user directly thus saving time.

19. In regards to claim 5, Bowen discloses the method of claim 2 further comprising enabling the first user to identify personal characteristics; enabling the first user to save the personal characteristics; and enabling the first user to make the personal characteristics accessible to a first remote computer system, a central computer system, and at least one other remote computer system (pgs 94-95, 207-209, and 381: "create and read personal bios").

20. In regards to claim 6, Bowen discloses a user identifying personal characteristics including interests such as gardening (pg 208) which examiner contends is also a hobby.



21. In regards to claims 7-8 and 10-11, Bowen discloses the system of claim 2 above where a user makes profile information available to others. Claims 7-8 and 10-11 are directed to a first user accessing the information of second user. Bowen teaches the system of claim 2 above including a multi-user online environment where users may search each other's profiles (pg 208 search by). Accordingly it also teaches a user accessing another person's profile.

22. Claims 4 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bowen in view of official notice as applied to claim 2 above, and further in view of Stults; Robert A. et al. (US 4987492).

23. In regards to claims 4 and 9, Bowen discloses the method of claim 2 above and further discloses that it is desirable for users to be able to see images of other users (pg 410), but lacks comprising: enabling the first user to select a visage; enabling the first user to save the visage; and enabling the first user to make the visage accessible to a first remote computer system, a central computer system, and at least one other remote computer system.

24. In related prior art, Stults discloses a technique by which a user is able to control an audio/video communication system in a computer network system where visages are used to represent users of a particular computer (6:63-66) and further states any other visual cues could be used, including an image of a face, a name, a character, a number and the like (6:66-7:2). One skilled in the art would recognize the advantages of being able to identify a user visually to provide easily recognizable indicators of users and allow users to see each other over a network.

25. Therefore it would have been obvious to one skilled in the art at the time of the invention to have modified Bowen in view of official notice further in view of Stults in order to include a visage of users to facilitate identification and the user's experience while using the networked communication system.

***Conclusion***

26. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. References are cited on attached PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID W. DUFFY whose telephone number is (571)272-1574. The examiner can normally be reached on M-F 0830-1700.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan M. Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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DWD

A handwritten signature in black ink, appearing to be 'DWD' with a stylized flourish.

/Corbett Coburn/  
Primary Examiner  
AU 3714